1745

Attorney Docket No. 3012 P0002

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:
Dr. Braja Mandal and Dr. Robert Filler

Examiner: Carol Diane Chaney

Serial No.: 09/879,633

Art Unit: 1745

Filing Date: June 12, 2001

Entitled:
Thermal Runaway Inhibitors

APPLICANTS' INTERVIEW SUMMARY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

On July 02, 2003 the undersigned conducted a telephonic interview with Examiner Carol Diane Chaney, and the Applicants and their counsel thank Examiner Chaney for her time. This summary constitutes a recordation contemplated by 37 C.F.R. § 1.133 and MPEP § 713.04.

A. Brief Description of Nature of any Exhibit or Demonstration
None.

B. Identification of Claim(s) Discussed
All, in the context of the restriction requirement.

C. Identification of Specific Prior Art Discussed
None.

D. Identification of Principal Proposed Amendments Discussed
None.

E. General Identification of Principal Argument Discussed

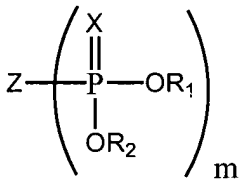
Applicants' principal argument is that it is erroneous to require selection of a species for prosecution from a generic claim. The argument is best understood from the below narrative.

The undersigned counsel and Examiner Chaney discussed the restriction requirement detailed in the Office Action of June 18, 2003 (the "Action"). The Action restricts Applicants' claimed invention to one of the following groups:

Group I:	Claims 1-25, 39 and 40
Group II:	Claim 26
Group III:	Claims 27-33
Group IV:	Claims 34-38

The Action requires that if Group I is elected for prosecution, then the Applicants must chose a single species defined by claim 4 (Action at pp. 4-6). Prosecution will be restricted to that chosen species if no generic claim – claims 1 through 4 – is allowed (*Id.* at 6).

Claim 4, a generic claim, recites:

> The battery of claim 1 wherein the compound that chemically interferes with flame propagation comprises a compound having the general structure:
>
> 
>
> wherein X is oxygen or sulfur;
>
> wherein R_1 is selected from the group consisting of (a) C_1 to C_{12} alkyl moieties that are terminally substituted with zero to three halogen atoms; (b) C_5 to C_7 aryl groups substituted with zero to four alkyl, haloalkyl, or alkoxy moieties; and (c) trialkylsilyl moieties, wherein the alkyl group has from about 1 to about 6 carbons;
>
> wherein R_2 is selected from the group consisting of (a) C_1 to C_{12} alkyl moieties that are terminally substituted with zero to three halogen atoms; (b) C_5 to C_7 aryl groups substituted with zero to four alkyl, haloalkyl, or alkoxy moieties; and (c) trialkylsilyl moieties, wherein the alkyl group has from about 1 to about 6 carbons;

wherein Z is a moiety selected from the group consisting of (a) aryl, aralkylene, arylene, dialkylamino, diarylamino, alkylarylamino, trialkyleneamino, cyclic amino, cyclic amido, cyclic imido, or oxy derivatives thereof; and (b) trialkylalkyleneoxysilane, dialkyldialkyleneoxysilane, alkyltrialkyleneoxysilane, and tetraalkyleneoxysilane; and

wherein m is an integer from 1 to 4.

As stated above, the Action requires Applicants to chose a species defined by claim 4 if Group I is elected for prosecution, even though the Action identifies claim 4 as generic. During the teleconference, Applicants' counsel informed the Examiner of the impropriety to require an election of species from a generic claim. The following example was discussed to illustrate counsel's argument.

If the "X" moiety of claim 4 were elected as oxygen, and claim 4 were then allowed (regardless of what was chosen for the other moieties), then it would be impossible to rewrite claim 4 in dependent form to include all the limitations of the allowed claim (where "X" must be oxygen) to include the other species, such as where "X" is sulfur. *See, e.g.*, Action at p. 6 (stating that "[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141"). The impossibility arises because for Applicants to have the Examiner consider additional species of claim 4 if claim 4 were allowed, they would be forced to rewrite an allowed claim to include the other species recited in the original form of the claim. This is precisely why a generic claim and a species claim cannot be the same claim.

After considering counsel's above argument, The Examiner maintained the restriction requirement.

F. Other Pertinent Matters Discussed
None.

G. Results of Interview
No agreement reached. Counsel informed the Examiner that he would consult the Applicants to determine which Group would be elected for prosecution.

H. Copies of Internet E-mail, if Conducted via Email
Not applicable.

CONCLUSION

Applicants submit the above constitutes a complete, written statement as contemplated by 37 C.F.R. 1.133 and MPEP § 713.04. Applicants respectfully request this paper to be made of record in the above-identified application. The Examiner is requested to contact the undersigned if the Examiner has any questions.

Respectfully submitted,

Date: July 03, 2003

By: _____

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I hereby certify that this paper or fee is being deposited with the United States Postal Service as a U.S. first-class mail in an envelope, with sufficient postage prepaid thereon, addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 03, 2003, as well as by faxing all papers to (703) 872-9310.

Carol J. Wiechers
(178212)

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Re: Applicant's Interview Summary of July 2, 2003 Interview

Comments/Notes:

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